

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q90376

Takayuki KATO, et al.

Appln. No.: 10/549,904

Group Art Unit: 1773

Confirmation No.: 7150

Examiner: Elizabeth A. Robinson

Filed: September 20, 2005

For: HOLLOW CERAMICS PARTICLES, HOLLOW CERAMICS PARTICLES-
CONTAINING COMPOSITE MATERIAL AND SLIDING MEMBER

REQUEST TO WITHDRAW FINALITY

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit that the final Office Action dated March 4, 2008 was improperly made final. The Office Action indicates that claims 1-9 stand rejected under 35 U.S.C. § 102(b) as assertedly being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as assertedly being obvious over JP 2003-160330 ("Kato").

Applicants respectfully solicits withdrawal of the finality of the Office Action for the following reasons.

In the Amendment filed December 6, 2007, Applicants argued that Kato is not prior art under 35 U.S.C. § 102(b) as of its publication date of June 3, 2003, which is not more than one year from Applicants' PCT filing date of March 18, 2004. Furthermore, to remove Kato as a reference under 35 U.S.C. §§ 102(a)/103(a), Applicants filed a verified English translation of their foreign priority documents, JP 2003-77971 and JP 2003-77972, together with a statement showing that the foreign priority documents have support for each claim under 35 U.S.C. § 112.

In response, the Examiner stated that Applicants' filing date is the U.S. filing date of September 20, 2005 and not the PCT filing date because Applicants' PCT was not filed in English.

Applicants submit that the Examiner has made an error in stating that Applicants' PCT must be filed in English and that the effective filing date of a National Stage Application is also the filing date of the national stage application. (See M.P.E.P. § 1893.03(b)). Furthermore, there is no requirement that the PCT application be filed in the English language. Under PCT Article 11(3), "an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which shall be considered to be the actual filing date in each designated State." Thus, Kato is not prior art under 35 U.S.C. § 102(b) and therefore finality of the rejection based on Kato is improper.

During a telephonic interview on April 11, 2008, Applicants requested withdraw of finality based on the aforementioned rationale. The Examiner conceded with Applicants' position and indicated that the finality will be withdrawn upon request, for which Applicants submit the present request.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Sunhee Lee/

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Date: April 17, 2008